

REMARKS

Claims 1–15, 40–54, 61–69 and 77–90 have been examined and stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Publication No. 2004/0199467 (“Martin”) in view of U.S. Patent No. RE38,255 (“Levine”) and IBM Research Disclosure RD414097 (“IBM”). The rejections are respectfully traversed. Claims 16–39, 55–60 and 70–76 are cancelled without prejudice or disclaimer by this paper.

1. Cited Prior Art

It is useful as an initial matter to consider the context of each of the three references cited as prior art, particularly with respect to the use of personal identification numbers (“PINs”). First, Martin is relied on in the Office Action for most limitations of each of the claims, although the Office Action generally acknowledges that Martin fails to disclose the use of a pair of PINs (*see, e.g.*, Office Action, page 3). The Office Action generally relies on Levine and IBM for these disclosures.

Second, Applicant respectfully disagrees with the Office Action’s characterization of Levine as disclosing the use of a pair of PINs. The application of Levine to specific claim language in each of the independent claims is discussed in detail below. The Office Action cites three passages in Levine as disclosing the use of a pair of PINs. One passage that is cited is the following.

The account database is consulted, looking up the entries corresponding to that BIN (step J). Once that sector of the database is located, the particular account number is located (step K). The inventory status data stored with the account number is located (step K). The inventory status data stored with the account number is checked to determine if the serial number received was distributed to that sales agent. The customer data and currency amount is then entered into the blank fields corresponding to that account number in the database (step L). The account number and the PIN number stored in the database (or a new PIN number transmitted by the customer) are then transmitted to the VisaNet system for updating of the PCAS software (step M). Finally, an acknowledgement message is sent back to the sales agent (step N).

(Levine, column 6, lines 11–24.)

This passage describes generally the operation of software at an agent terminal. The passage suggests that the PIN that is transmitted is normally a PIN stored in a database, but could be a new PIN transmitted by a customer. Nothing in the passage suggests the simultaneous existence of both these PINs and certainly does not teach or suggest that a pair of PINs are comprised by a payment service request — as described in this passage, only a single PIN is relevant, the disclosure merely noting that the single PIN may be drawn from a database or directly from the customer.

Another passage that is cited is the following.

[The] ATM also transmits a currency code which show what currency is in the ATM. The VisaNet network performs any required currency translation (step D). The ETC processor software then looks up the card number in the database (step E), and the PIN number associated with the account in the database is compared to the transmitted PIN number (step F). If the PINs don't match, a return error message is transmitted to the ATM (step G).

(Levine, column 7, lines 1–9.)

This passage merely describes the verification of a PIN. It does not teach or suggest that a pair of PINs are comprised by a payment service request — again, only a single PIN is relevant.

The final passage that is cited is the following.

FIG. 8 illustrates the operation of the service agent software for assigning a new PIN number where a customer desires a new PIN or has forgotten the PIN number. The service agent first inputs the customer name and any other identifying data that is available, along with the desired new PIN number (step A). The old PIN could also be required, except for a lost PIN. This information is then transmitted to the ETC processor computer (step B). The ETC processor computer compares the account information to determine whether there is sufficient information to claim

that account (step C). If there is insufficient or non-matching information, an error message is returned (step D).

Otherwise, the PIN number assigned to that account is updated (step E). The new PIN number is also transmitted to the PCAS issuer record database in the VisaNet system for updating as well (step F). Finally, an acknowledgement message is returned to the service agents software (step G).

(Levine, column 7, lines 39–55.)

This passage merely describes the updating of a PIN. It does not teach or suggest that a pair of PINs be comprised by a payment service request.

It is apparent that the passages cited from Levine merely describe such routine operations as updating a PIN or verifying a PIN. Such operations never involve a pair of PINs as part of a payment service request since, at any given time, only a single PIN has actual functionality.

IBM is somewhat different in that it discloses two PINs that have actual functionality at the same time. But in this instance, the two PINs are intended to perform different functions, with only a single one of the PINs being provided as part of any service request.

The basic idea of this disclosure is the dual PIN access modes which provide two PINs for you credit, ATM or smart cards. Both PINs will allow the card owner to perform the function the card supposed to do. But the second PIN will provides additional functions than the first PIN. If someone is forced to withdraw money from the bank with one's ATM card by the criminal, one can simply punch in the second PIN of one's ATM card. This will perform additional functions, such as sending a silent robbery alarm to the police or the security guard in addition to allow one to withdraw cash successfully. In this case, the criminal even doesn't know that his or her crime has been reported.

(IBM, page 1.)

Since only one or the other of the PINs may be used, this fails to teach or suggest having a pair of PINs as part of a payment service request.

Thus, to the extent that combining Martin with Levine and/or IBM is proper, the combination merely teaches that the system of Martin equipped a mechanism for changing a PIN, verifying a PIN, and/or having two PINs that might be used to initiate different types of operations. All of these operations still make use of only a single PIN in any service request. Nothing in the combination teaches or suggests a service request that has a pair of PINs.

2. Claims 1–15

Independent Claim 1 is believed to be patentable over the cited art because the art fails to teach or suggest the claim limitation of “processing a payment service request having . . . a pair of ATM network compatible PINs.” As noted in the discussion of the prior art above, nothing in any of the references teaches the inclusion of a pair of PINs in a payment service request, the description in all of the references always being limited to including only a single PIN in a service request. Indeed, both Levine and IBM teach away from use of such a pair of PINs by teaching exclusive use of a single PIN in service requests, a factor that has long been recognized as indicating that the combination is *not* obvious. Dependent Claims 2–15 are also believed to be patentable by virtue of their dependence from a patentable claim.

3. Claims 40–54

Independent Claim 40 is believed to be patentable for substantially the same reasons, in particular because the cited art does not teach or suggest “a processor for processing a payment service request having . . . a pair of ATM network compatible PINs.” Since the cited prior art is limited to disclosing the inclusion of only a single PIN in a service request, it does teach or suggest the claim limitation. Dependent Claims 41–54 are also believed to be patentable by virtue of their dependence from a patentable claim.

4. Claims 61–69

Independent Claim 61 is believed to be patentable because the cited art fails to disclose “providing an encoded data storage device to a user” that includes both “data representing a first ATM network compatible PIN [that is] a valid ATM PIN associated with said user’s account at a financial institution” and “data representing a second ATM network compatible PIN [that is] an invalid ATM PIN not associated with said user’s account at said financial institution.”

First, Levine never teaches the inclusion of two PINs on an encoded data storage device that is provided to a user. While Levine teaches certain updating functions, only a single PIN is ever identified by the card described in Levine.

Second, while IBM arguably does teach the inclusion of two PINs on a card provided to a user, “[b]oth PINs will allow the card owner to perform the function the card [is] supposed to do” (IBM, page 1). It clearly teaches away from the “data representing [the] second . . . PIN [being] an invalid ATM PIN not associated with said user’s account,” a factor that argues strongly that the proposed combination is *not* obvious.

Claims 62–69 are dependent from Claim 61 and are, accordingly, also believed to be patentable.

5. Claims 77–90

Independent Claim 77 is a means-plus-function claim that approximately parallels independent system Claim 40. None of the cited art teaches or suggests a “means for generating a payment service request having . . . a pair of ATM network compatible PINs” for reasons discussed above in connection with Claims 1–15 and Claims 40–54. Namely, the cited prior art is limited to disclosing the inclusion of only a single PIN in a service request. The claim is, accordingly, believed to be patentable, and Claims 78–90 are similarly believed to be patentable because of their dependence from Claim 77.

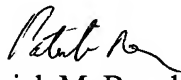
6. Conclusion

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: 2005 October 6


Patrick M. Boucher
Reg. No. 44,037

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
PMB:pmb
60593183 v1